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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,668	06/20/2000	Gavin Peacock	PALM-3215	5356

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Wagner Murabito & Hao LLP
Two North Market Street
Third Floor
San Jose, CA 95113

EXAMINER

SHAW, JOSEPH D

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,668

Applicant(s)

PEACOCK, GAVIN

Examiner

Joseph D Shaw

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 1 recites the limitation "said identified communication mechanism" in lines 14-15 and lines 19-20. There is insufficient antecedent basis for this limitation in the claim.

- b. Claim 8 recites the limitation "said identified communication mechanism," in line 10 and line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 7, 8, 9, 14, 15, and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Peacock et al. (6,601,111) in view of Joseph (6,038,603).

5. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

c. As per claims 1 and 8, Peacock discloses an Exchange Manager that performs all communication in a computer system between applications and external communication hardware (Fig. 2, Fig. 3, col. 3, lines 9-14); the

exchange manager handles different protocols through transaction with a communication library (col. 3, lines 15-20; Fig. 3); transferring data to an external system via protocols and mechanisms defined in the Exchange Manager (Fig. 3; Fig. 6); and the computer system being a portable computer (handheld device) (col. 4, lines 48-50; Fig. 6). However, Peacock does not explicitly teach the application forwarding, to the Exchange Manager, data associated with a URL string, the URL string containing a transport mechanism and a destination. Joseph discloses a URL containing a transport mechanism and destination that a browser (application) uses to communicate with another computer (Fig. 3A,B; col. 4, lines 55-67, col. 5, lines 1-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the method of browser communication via URL's as taught by Joseph in the system of Peacock because such an arrangement would allow browsers (application), on handheld computer systems, to take advantage of the Exchange Manager's ability to communicate using different protocols and media.

d. As per claim 15, Peacock discloses a portable computer (handheld device) (col. 4, lines 48-50; Fig. 6); the portable computer receiving data (Abstract; Fig. 4; col. 5; lines 44-45); and the Exchange Manager using an application registry to determine what kind of data is received (Abstract; col. 3, lines 54-63). Peacock does not explicitly teach storing the file into memory. In addition, Peacock does not explicitly teach the file being transmitted to the handheld

device based on a URL. However, it is inherent that the data must exist in memory on the device. Joseph discloses URL's used to specify a target system for data communications (col. 2, lines 8-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the method of using URL's to specify a computer to communicate with as taught by Joseph in the system of Peacock because URL's would allow for the unique identification of resources in data communications as taught by Joseph (col. 2, lines 8-10).

e. As per claims 2 and 9, Peacock discloses the claimed invention modified by Joseph as described above and furthermore teaches the handheld device being a mobile computing device (a palmtop computer) (Fig. 6; col. 7, lines 20-23; col. 7, lines 38-44). However, the Peacock/Joseph invention does not disclose the palmtop computer comprising a memory, processor, screen, and plurality of communication mechanisms coupled to a bus. "Official Notice" is taken that both the concept and advantages of a palmtop computer comprising a processor, memory, screen, and plurality of communication mechanisms are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a memory, processor, screen, and plurality of communication mechanisms coupled to a bus in a palmtop computer because such an arrangement would allow for a working palmtop computer.

f. As per claim 16, the claim differs from claims 2 and 9 only in the fact that it is dependent on different parent claims, one sends data and the other receives. Therefore, claim 16 is rejected on the same merits that claims 2 and 9 are.

g. As per claims 7 and 14, Peacock discloses the claimed invention modified by Joseph as described above. However, the Peacock/Joseph invention does not disclose prompting the user for any unspecified criteria including protocol to use or destination. "Official Notice" is taken that both the concept and advantages of a system prompting a user for unspecified criteria are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include prompting users for unspecified criteria because it would ensure that data communications occurred though a program did not explicitly specify a protocol or destination.

h. As per claim 21, Peacock discloses the claimed invention modified by Joseph as described above. However, the Peacock/Joseph invention does not disclose prompting the user to specify an application to associate an unknown data type with. "Official Notice" is taken that both the concept and advantages of a system prompting a user for an application to associate unknown data with are well known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include prompting

users for application association of because it would allow for users to view unknown data with the application they desire.

6. Claims 3-5, 10-12, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock et al. (6,601,111) in view of Joseph (6,038,603) as applied to claims 1 and 7 above, and further in view of Bodnar et al. (6,295,541).

i. As per claims 3, 4, 10, and 11, Peacock discloses the claimed invention modified by Joseph as described above and furthermore teaches including protocols for IP (col. 3, lines 21-28) and infrared (col. 3, lines 33-35; Fig. 3). However, the Peacock/Joseph invention does not explicitly teach including an email, radio frequency, or synchronization protocols. Bodnar teaches a palmtop computer capable of synchronization, radio frequency communications, and email communications (col. 10, 42-53; Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the methods of synchronization, radio frequency, and email communications in a palmtop computer as taught by Bodnar in the system of Peacock/Joseph because including such protocols would allow for additional options in communication media with the palmtop computer.

j. As per claims 17 and 18, the claims differ from claims 3, 4, 10, and 11 only in the fact that they are dependent on different parent claims, one sends data and the other receives. Therefore, claims 17 and 18 are rejected on the same merits that claims 3, 4, 10, and 11 are.

k. As per claims 5 and 12, Peacock discloses the claimed invention modified by Joseph as described above. However, the Peacock/Joseph invention does not explicitly teach sending a data file. Bodnar teaches a palmtop computer sending datasets (data files) (Fig. 2; col. 10, lines 23-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include sending datasets from a palmtop computer as taught by Bodnar in the system of Peacock/Joseph because it would allow for the synchronization of datasets as taught by Bodner (Abstract).

l. As per claim 19, the claim differs from claims 5 and 12 only in the fact that it is dependent on different parent claims, one sends data and the other receives. Therefore, claim 19 is rejected on the same merits that claims 5 and 12 are.

7. Claims 6, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peacock et al. (6,601,111) in view of Joseph (6,038,603) as applied to claims 1 and 7 above, and further in view of Suzuki (6,385,636).

m. As per claims 6 and 13, Peacock discloses the claimed invention modified by Joseph as described above. However, the Peacock/Joseph invention does not explicitly teach sending an application program. Suzuki teaches a client computer being transmitted an application (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include transmitting applications between computer systems as taught by Suzuki

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in the system of Peacock/Joseph because this would allow for workloads to be distributed in the computing environment as taught by Suzuki (Abstract).

n. As per claim 20, the claim differs from claims 6 and 13 only in the fact that it is dependent on different parent claims, one sends data and the other receives. Therefore, claim 20 is rejected on the same merits that claims 6 and 13 are.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Shaw whose telephone number is 703-305-0094. The examiner can normally be reached on Monday - Thursday, 6:30 AM - 4:00 PM, and on alternate Fridays.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-

5484.



JDS



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER